

Amendments to the Claims

Please amend Claims as indicated below:

1. (Currently Amended) An optically responsive ~~element~~ device capable of altering incident light ~~characterized in that it comprises~~ comprising a means for providing a magnetic field and one or more transparent, paramagnetic elements that are physically or passively responsive to a the magnetic field provided by the ~~and a~~ means for providing the magnetic field, the one or more transparent, paramagnetic elements being optical solids or optical fibers comprising in whole or part a transparent, paramagnetic polymer composition comprising a polymer complexed with a sufficient amount of one or more rare earth ions selected from the group consisting of elements 64 – 69 to provide a polymer composition magnetic mass susceptibility of greater than 20×10^{-6} emu/g measured at 298°K.
2. (Currently Amended) The optically responsive ~~device element~~ of claim 1 wherein the rare earth ions are selected from the group consisting of elements 66-67.
3. (Currently Amended) The optically responsive ~~device element~~ of claim 1 or 2 ~~comprising that is~~ an optical switch for use in optical fiber communication systems comprising wherein:
 - (a) the transparent, paramagnetic element is a solid article capable of moving into and out of a path of incident light such that the when the solid article is moved into the initial path of incident light, the incident light passing through the solid article is redirected to a different path; and
 - (b) the magnetic field provided by the means for providing a source of magnetic field is positioned to move the solid article into and out of the path of incident light.
4. (Currently Amended) The optically responsive ~~device element~~ of claim 1 or 2 ~~that is comprising~~ an optical switch for use in optical fiber communication systems wherein comprising:
 - (a) a transparent, paramagnetic element is an input optical fiber for transmitting an incoming light signal wherein the optical fiber comprises the composition of one or more transparent, paramagnetic polymers that have a magnetic mass susceptibility of greater than 20×10^{-6} emu/g measured at 298°K;

- (b) one or more transparent, paramagnetic elements are ~~is one or more~~ output optical fibers ; and
 - (c) the magnetic field provided by one or more means for providing a one ~~or more sources of magnetic field~~ is positioned to move the input first optical fiber to align with one of the output optical fibers.
5. (Currently Amended) The optically responsive device element of claim 1 wherein the polymer from which the transparent, paramagnetic polymer is made is a non-ethylene containing polymer.
6. (Currently Amended) The optically responsive device element of claim 3 wherein the polymer from which the transparent, paramagnetic polymer is made is a non-ethylene containing polymer.
7. (Currently Amended) The optically responsive device element of claim 4 wherein the polymer from which the transparent, paramagnetic polymer is made is a non-ethylene containing polymer.

Remarks

Claims are amended to overcome the non-art rejections. The “optically responsive element” now reads “optically responsive device” (see p. 6, l. 28 for basis). It is now clear that the device has a means for creating a magnetic field and one or more transparent, paramagnetic elements. The paramagnetic elements are physically or passively responsive to the magnetic field created by the means for doing so.

Non-Art Rejection

Claims 3 – 4 and 6 – 7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant requests reconsideration and withdrawal of this rejection in view of the above amendments.

Double Patenting

Claims 2 and 5 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 7, and 13 of copending Application No. 10/050281. The cited basis for this provisional rejection is that there is no patentable distinction between the “device” of the present claims and the “composition” of the copending application.

Applicants respectfully traverse this provisional rejection and ask for reconsideration and withdrawal in view of the following.

35 U.S.C. §101 provides: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”

The device claims of the present invention can be viewed either as claims to an article of “manufacture” or to a “useful process” for the “composition of matter”. Thus, “devices”, even if made from the same composition of matter claimed in the copending application, fall into a different class than the composition of matter itself. For this reason alone, they are not drawn to the “identical subject matter” and a statutory double patenting rejection cannot stand.

Novelty Rejection – Yoshioka et al.

At present, Claims 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Yoshioka et al. Reconsideration of this rejection is requested in view of the following remarks.

For the novelty rejection to stand, all the limitations in the claims must be taught or inherent in the single reference. Such is not the case with Yoshioka et al. Yoshioka et al. discloses a complexed gadolinium dispersed in a film. There is no mention of an optically responsive device having a means for creating a magnetic field and one or more transparent, paramagnetic elements that are optical solids or optical fibers that are physically or passively responsive to the magnetic field provided by the means for providing the magnetic field. Further, the limitations that are missing from the literal language of Yoshioka et al. cannot be inherent in the reference. It is not clear what the film is used for, but for sure it is not always if ever used in a device such as is currently claimed.

In view the above, Applicants respectfully request withdrawal of the novelty rejection.

Allowable Subject Matter – Claims 3 – 4 and 6 - 7.

Applicants note the allowability of Claims 3 – 4 and 6 – 7, and believe that with the amendment of the claims from which these depend that they are now allowable without placing them into independent form. Accordingly, Applicants request that they be considered again in their amended form.

Conclusion

In view of the above remarks and amendments, it is felt that all claims are now in condition for allowance and such action is requested. Should the Examiner believe that an interview or other action would expedite prosecution, the Examiner is urged to contact Applicants' attorney by telephone at (302) 992-3219.

Respectfully submitted,



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